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10/707,510

12/18/2003

Frederick W. Ryan JR.

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919 7590 10/09/2008

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EXAMINER

JABR, FADEY S

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

10/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,510	Applicant(s) RYAN ET AL.	
	Examiner FADEY S. JABR	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims **1, 20** and **21** have been amended. Claims **1, 3-12, 14** and **16-23** remain pending and are again presented for examination.

Response to Arguments

1. Applicant's amendments filed 26 June 2008 with respect to 35 U.S.C. 112, second paragraph have been fully considered and are therefore withdrawn.
2. Examiner notes that Official Notice was not taken and no reference is required.
3. Applicant argues (with respect to claim 1) that neither of the cited references teach prompt refund processing followed by determining if the refund request is valid. Applicant further argues that Montgomery teaches away from paying before review. Examiner notes that Montgomery does not teach away from paying before review. [A] reference will teach away if it suggests that the line of development flowing from the reference's disclosures is unlikely to be productive of the result sought by the applicant. In re Gurley, 31 USPQ2d 1130 (Fed. Cir. 1994).

Further, Montgomery teaches the refund inquiry can take a variety of formats...(1) two or more transactions...(1) the end user's account will be credited for the misprint; (2) the misprint postage transaction information will be date/time stamped in the postage database and flagged as "refunded"; (3) a refund request is issued to postage refund request and (4) the refunded postage transaction is entered into a statusing database, so that the delivery status can be checked for six months (0170). Thus, Montgomery teaches if two or more transactions occur, then a user's

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account will be credited for the misprints, after which monitoring of the statusing database will occur to determine the validity of the refund.

4. Applicant argues (with respect to claim 20) that none of the cited references teach variable test periods based upon the lifetime of the codes. However, Examiner notes that Gullo discloses that the particular IBI is associate with the tracking/label number and/or transaction number (0019). Further, Gullo teaches a designated test period, where the period may be varied (0020). Moreover, Montgomery teaches checking the delivery status for six months (0188). Therefore, the references teach a variable test period associated with the tracking number.

5. Applicant argues (with respect to claim 21) that none of the cited references teach prior postage dispense operation association with the user and such variable test periods. Examiner notes that the claim recites, "...prior postage dispense operation associated with the user and determining whether the tracking identifier..." Further, Examiner notes that Gullo teaches the information should further be processed to ensure that the particular IBI associated with the tracking /label number and/or transaction number was not previously voided or refunded, and/or that there is not an active scan event for the tracking/label number. If the customer does not meet the fraud-prevention criteria, then the system denies the request (0019). Therefore, Gullo teaches that IBI postage dispensed is associated with the user.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, support has not been found for the limitation, “paying the refund request substantially immediately after receiving the request and before review of the refund request to determine validity”. Appropriate correction is required in the indicated claims and any subsequent claims.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 1**, the recitation, "*substantially*" is vague and indefinite. It is unclear to the Office what the applicant means by the term. Appropriate correction is required in the indicated claims and any subsequent claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims **1, 3-12** and **14-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gullo et al., Pub. No. US2004/0044586 in view of Montgomery et al., Pub. No. US2003/0101147 A1, hereinafter referred to as Gullo and Montgomery, respectively.

As per **Claim 1**, Gullo discloses a method for processing a postage refund request for a mail piece comprising:

- receiving a refund request including a tracking identifier from a user system (0015);
- determining if the refund request is valid (0018-0019);
- if the refund request is not valid, initiating a refund error process, wherein (0018-0019, also see Figure 2),
- the determination of whether the refund request is valid includes determining whether the tracking identifier has been observed in a mail stream (0019-0020).

Gullo fails to disclose processing and paying the refund request substantially immediately after receiving the request and before review of the refund request to determine validity.

Montgomery teaches the refund inquiry can take a variety of formats...(1) two or more transactions...(1) the end user's account will be credited for the misprint; (2) the misprint postage transaction information will be date/time stamped in the postage database and flagged as "refunded"; (3) a refund request is issued to postage refund request and (4) the refunded postage transaction is entered into a statusing database, so that the delivery status can be checked for six months (0170). Thus, Montgomery teaches if two or more transactions occur, then a user's

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account will be credited for the misprints, after which monitoring of the statusing database will occur to determine the validity of the refund.

Gullo discloses processing a refund request (0019-0020). Gullo fails to *explicitly* disclose monitoring the tracking identifier after processing the refund request in order to determine if the mail piece is used after a refund payment. Gullo discloses the information should further be processed to ensure that the particular IBI associated with the tracking/label number and/or that there is not an active scan event for the tracking/label number (0019).

Montgomery teaches the end user's account will be credited for the misprint; the misprint postage transaction information will be date/time stamped in the postage database and flagged as "refunded"; a refund request is issued to a postage refund center and the refunded postage transaction is entered into a statusing database, so that the delivery status can be checked for six months (determining if the refund request is valid) (0170, 0188). Montgomery shows that the step of providing a refund then determining if the transaction has been subsequently used. Further, Montgomery teaches the postal authority enters the refunded postage transaction into the master tracking computer system, where the delivery status can be checked for six more months...the refunded postage polling module periodically polls the tracking information database to determine if a mail piece associated with any refunded postage transaction has been delivered (0188).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo and include providing a refund then processing the refund request for validity and monitoring for the scan events of the transaction as taught by Montgomery since the claimed invention is merely a combination of old

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elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.

As per **Claim 3**, Gullo discloses the refund error process includes a fraud inquiry (0019-0021).

As per **Claim 4**, Gullo fails to *explicitly* disclose the refund error process includes notifying a postal authority. However, Gullo discloses a system that may be carried out online or by directly going to a local post office. Therefore, when a user receives a refund error from the system (operated by the USPS) they are receiving the notification from the postal authority (Figure 1). Moreover, when a user has their account suspended for suspicion of fraud, they have to contact the local post office to reactivate their account (0021). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo and include notifying a postal authority, because it allows the postal authority to suspend fraudulent postal accounts therefore preventing further fraud.

As per **Claim 5**, Gullo discloses determining if the mail piece is associated with the user that submitted the refund request (0018).

As per **Claim 6**, Gullo fails to *explicitly* disclose determining if a refund test period has completed; and if the refund test period is not completed, performing another determination of

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whether the mail piece has been observed in the mail stream. However, Gullo discloses queuing the request for a designated period, for example, seven days, to check for scan events (0019-0020). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gullo and include queuing for scan events over a designated period of time, because it allows the system to check multiple scan events over a designated period of time to ensure that there is not an active scan event for the tracking/label number (0019).

As per **Claims 7-10**, Gullo fails to disclose the tracking identifier includes a 22-digit delivery confirmation PIC code, a PLANET code and a POSTNET code, a postage serial number and a postage meter postage ascending register value, or a postal ID tag. However, Montgomery teaches a method for detecting postage fraud using tracking identifiers. Further, Montgomery discloses tracking identifiers being one or two-dimensional barcodes, PLANET or POSTNET codes (0060-0063, see Figures 19-22). Further, Montgomery teaches associating the information based indicium along with the tracking identifier, where the IBI contains ascending register value, license zip, the certificate serial number, etc. (0080, 0096, also see Table 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gullo and provide a tracking identifier that includes various codes and pertinent information as taught by Montgomery, because it allows the system to associate a plurality of information associated with the mail piece when attempting to track the mail piece through the mail stream.

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As per **Claims 11-12 and 16-18**, Gullo discloses sending the refund request to the postal authority (see Figure 1). Gullo fails to disclose processing the refund request includes aggregating a group of valid refund request associated with a postage broker, processing the refund request includes aggregating a group of valid refund requests received from a plurality of users and sending a group refund request associated with the aggregated group of valid refund request to a postal authority, sending aggregated refund request data to the postage broker. However, Montgomery teaches a refund eligible inquiry that allows a user or administrator working on behalf of the mail user to poll eligible refund requests, where a user can select the eligible refund requests to send to the USPS (000170-0171, 0174-175, see Figures 26-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Gullo and allow a user to choose from a plurality of postal transaction to select the transactions that require a refund in order to send to the postal authority as taught by Montgomery, because it allows a user to select the correct transaction or transactions from a plurality of transactions and more efficiently process the refund requests in order to minimize the refund return around time.

As per **Claim 14**, Gullo discloses the refund test period is variable (0020). Gullo fails to disclose the variable length of the refund test period *depends upon the class of service of the mail piece*. However, Gullo discloses the amount of time that would be considered an undue period may depend on administrator preference, but a period of between about 1 and 30 days is preferred, with a period of about 10 days being considered optimal (0019). Further, Gullo

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discloses the queuing the request for a designated period, for example seven days, to check for scan events. (This period may be varied) (0020).

Montgomery teaches the refunded postage transaction is entered into a statusing database, so that the delivery status can be checked for six months (0170, 0174).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo, and include many variable test periods as taught by Gullo and Montgomery since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 19**, Gullo discloses the tracking identifier is unique over a first period of time (0015).

As per **Claims 20 and 21** Gullo discloses a method for processing a postage refund request for a mail piece comprising:

- receiving a refund request including a tracking identifier from a user system (0015);
- determining if the refund request is valid (0018-0019);
- if the refund request is not valid, initiating a refund error process (0018-0019, also see Figure 2);
- if the refund request is valid, processing the refund request (0019-0020), wherein,

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- the determination of whether the refund request is valid includes determining whether the tracking identifier has been observed in a mail stream (0019-0020).

Gullo fails to *explicitly* disclose receiving a plurality of refund requests from each of a respective plurality of user systems. However, Gullo discloses receiving a user request. The system of Gullo however is capable of receiving more than refund request. Further, Montgomery teaches a user interface which lists multiple transactions in which a user can select (see Figures 25-27). Moreover, Montgomery teaches a device ID that identifies the USPS-assigned ID for each postage vendor, and the user account for which the postage indicium will be issued (0096). Montgomery also teaches that the end user's account balance is securely stored in a centralized postage-issuing computer system (0003). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo and include allowing a plurality of refund requests.

Gullo discloses the refund test period is variable and the refund request corresponding to a prior postage dispense operation associated with the user (0019-0020). Gullo fails to *explicitly* disclose the variable length of the refund test period *depends upon a tracking code lifetime period* associated. However, Gullo discloses the amount of time that would be considered an undue period may depend on administrator preference, but a period of between about 1 and 30 days is preferred, with a period of about 10 days being considered optimal (0019). Further, Gullo discloses the queuing the request for a designated period, for example seven days, to check for scan events. (This period may be varied) (0020). Also, Gullo discloses that the particular IBI is associate with the tracking/label number and/or transaction number (0019). Further, Gullo teaches a designated test period, where the period may be varied (0020). Moreover,

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Montgomery teaches checking the delivery status for six months (0170, 0174, 0188). Therefore, the references teach a variable test period associated with the tracking number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo, and include many variable test periods as taught by Gullo and Montgomery since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 22-23**, Gullo fails to *explicitly* disclose monitoring the tracking identifier after processing the refund request in order to determine if the mail piece is used after a refund payment, if the mail piece is used after a refund payment, assessing a postage fee and fine. Gullo fails to *explicitly* disclose monitoring the tracking identifier after processing the refund request in order to determine if the mail piece is used after a refund payment. Moreover, Gullo discloses the information should further be processed to ensure that the particular IBI associated with the tracking/label number and/or that there is not an active scan event for the tracking/label number (0019). Furthermore, Gullo discloses tracking would permit the suspension of postage printing capabilities for such users, and/or the reporting of the identity of such a user to a body capable of taking further action against the user for submitting improper refund requests. It should be noted that provision can be made for such a user to repay the amount they owe (0021, also see Claim 21).

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Montgomery teaches the end user's account will be credited for the misprint; the misprint postage transaction information will be date/time stamped in the postage database and flagged as "refunded"; a refund request is issued to a postage refund center and the refunded postage transaction is entered into a statusing database, so that the delivery status can be checked for six months (determining if the refund request is valid) (0170, 0188). Montgomery shows that the step of providing a refund then determining if the transaction has been subsequently used. Further, Montgomery teaches the postal authority enters the refunded postage transaction into the master tracking computer system, where the delivery status can be checked for six more months...the refunded postage polling module periodically polls the tracking information database to determine if a mail piece associated with any refunded postage transaction has been delivered (0188).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo and include providing a refund then processing the refund request for validity, monitoring for the scan events of the transaction and assessing a penalty for fraudulent use of postage as taught by Gullo and Montgomery since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
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FSJ

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Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401
Dulany Street, Alexandria, VA 22314

/F. S. J./

Examiner, Art Unit 3628

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628